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EXAMINER
PATEL, NIRAV B

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 May 2008(RCE)</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-25</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-25</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>5/27/08</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

1. Applicant's submission for RCE filed on 5/27/08 has been entered. Claims 1-25

are pending. Claims 1, 11, 18 and 25 are amended by the applicant.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-25 provisionally rejected on the ground of nonstatutory obviousness-

type double patenting as being unpatentable over claims 1-26 of copending Application

No. 10/731655. Although the conflicting claims are not identical, they are not patentably

distinct from the each other because both use a rule associated with the record to

determine whether an electronic signature is required.

Claims 1-25 of the instant application contain every element of claims 1-26 of

copending Application No. 10/731655 and thus anticipate the claims of the instant

application. Claims of the instant application therefore are not patently distinct from the

earlier co-pending claims and as such are unpatentable over obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is **anticipated by**, the earlier claim.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness- type double patenting where a patent application claim to a genus is anticipated by a 35 patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001). "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is **"anticipated"** by the species of the patented invention. Cf., Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic application. In re Van Ornum, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); Schneller, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected

under the doctrine of obviousness-type double patenting." (In re Goodman (CA FC) 29

USPQ2d 2010 (12/3/1993).

        This is a <u>provisional</u> obviousness-type double patenting rejection because the

conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

        The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to
> a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

        3. Claims 1, 10-12, 18 and 19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Ludwig et al (US Pub. No. 2001/0021928) in view of Nishizawa et al.

(US Pub. No. 2001/0039545) in view of Spitz (US Patent No. 7,039,807) and in view of

Alley et al (US Pub. No. 2003/0078880).

<u>As per claim 1</u>, Ludwig teaches:

automatically creating an electronic record from data stored in a plurality of different

database tables associated with a database transaction in response to an occurrence of

a predetermined event [Fig. 6, paragraph 0044, 0045, 0054, Fig. 7]; initiating a request

to collect the required electronic signature prior to committing the database transaction to the database [Fig. 7, paragraph 0055, Fig. 11, 12, paragraph 0067-0078].

Ludwig teaches collecting the electronic signature for the electronic record as above.

Nishizawa teaches:

storing an instance of the electronic record in a common repository of electronic records that provides an audit trail that cannot be altered or disabled by users of associated with the database [Fig. 2, paragraph 0100, Fig. 7].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Nishizawa with Ludwig, since one would have been motivated to manage the electronic documents by which user can easily confirm the original entity of an electronic document [Nishizawa, paragraph 0013].

Nishizawa teaches the electronic record with an electronic signature [paragraph 0127]. Nishizawa doesn't expressively mention a rule associated with the electronic record to determine whether an electronic signature is required.

Spitz teaches executing a rule associated with the electronic record to determine whether an electronic signature is required to connote review and/or approval of the electronic record [col. 3 lines 31-38 col. 6 lines 60-67]; and if execution of the rule results in a determination that an electronic signature is required, initiating a request to collect the required electronic signature [col. 6 lines 15-19].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Spitz with Ludwig and Nishizawa, since one would

have been motivated to disguise the sensitive internal information and avoid an additional burden to the recipients duties [Spitz, col. 3 lines 1-13].

Nishizawa and Spitz do not expressively mention marking the instance of the electronic record as unsigned.

Alley teaches marking the instance of the electronic record as unsigned [Fig. 3, paragraph 0090 lines 16-19].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alley with Ludwig, Nishizawa and Spitz, since one would have been motivated to provide a electronic signature and manage the digital documents [Alley, paragraph 0014].

As per claim 10, the rejection of claim 1 is incorporated and Alley teaches the electronic record is initially marked as unsigned by setting an appropriate attribute associated with a database table in which at least part of the record is stored [Fig. 3, 6].

As per claim 11, it encompasses limitations that are similar to those of claim 1. Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 12, the rejection of claim 11 is incorporated and Nishizawa teaches the electronic record is stored in a common repository of electronic records that provides an

audit trail that cannot be altered or disabled by users of the database [Fig. 2, paragraph 0131, 0132].

As per claim 18, it encompasses limitations that are similar to those of claim 1. Thus, it is rejected with the same rationale applied against claim 1 above.

As per claim 19, the rejection of claim 18 is incorporated and it encompasses limitations that are similar to limitations of claim 3. Thus, it is rejected with the same rationale applied against claim 3 above.

4.   Claims 2, 3, 7, 16, 17, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig et al (US Pub. No. 2001/0021928) in view of Nishizawa et al. (US Pub. No. 2001/0039545) in view of Spitz (US Patent No. 7,039,807) in view of Alley et al (US Pub. No. 2003/0078880) and in view of in view of Hawkins et al (US Patent No. 7,146,500).

As per claim 2, the rejection of claim 1 is incorporated and Alley teaches receiving an electronic signature from the user and marking the instance of the electronic record as signed [Fig. 3, 0090].

Alley doesn't expressively mention verifying the electronic signature.

Hawakins teaches receiving an electronic signature from the user; verifying the electronic signature and in response to a positive verification of the electronic signature, adding the signature [Fig. 3, col. 5 lines 50-65].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hawakins with Ludwig, Nishizawa and Spitz and Alley, since one would have been motivated to provide secure environment and safe storage for storing the electronic record [Hawakins, col. 1 lines 8-9].

As per claim 3, the rejection of claim 2 is incorporated and Nishizawa teaches the electronic record is stored in a common repository of electronic records that provides an audit trail that cannot be altered or disabled by users of the database [Fig. 2, paragraph 0131, 0132].

As per claim 7, the rejection of claim 1 is incorporated and Spitz teaches execution of the rules results in a determination that an electronic signature is required [col. 6 lines 60-67].

Hawakins teaches:

if an electronic signature is required, displaying data from the electronic record on a computer display [col. 7 lines 21-34].

As per claim 16, the rejection of claim 11 is incorporated and it encompasses limitations that are similar to limitations of claim 2. Thus, it is rejected with the same rationale applied against claim 2 above.

As per claim 17, the rejection of claim 16 is incorporated and Alley teaches the electronic record is initially marked as unsigned by setting an appropriate attribute associated with a database table in which at least part of the record is stored [Fig. 3, 6].

As per claim 23, the rejection of claim 18 is incorporated and it encompasses limitations that are similar to limitations of claim 2. Thus, it is rejected with the same rationale applied against claim 2 above.

As per claim 24, the rejection of claim 23 is incorporated and it encompasses limitations that are similar to limitations of claim 17. Thus, it is rejected with the same rationale applied against claim 17 above.

5. Claims 4-6, 13-15 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig et al (US Pub. No. 2001/0021928) in view of Nishizawa et al. (US Pub. No. 2001/0039545) in view of Spitz (US Patent No. 7,039,807) in view of Alley et al (US Pub. No. 2003/0078880) and in view of in view of Chang et al (US Patent No. 6,584,459).

As per claim 4, the rejection of claim 1 is incorporated and Nishizawa teaches the electronic record comprises unstructured data [paragraph 0016, 0017].

Nishizawa doesn't expressively mention a character large object (CLOB) format.

Chang teaches unstructured data in a character large object (CLOB) format [Fig. 3].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Chang with Ludwig, Nishizawa and Spitz and Alley, since one would have been motivated to manage and store the digital documents [Alley, paragraph 0014].

As per claim 5, the rejection of claim 1 is incorporated and Chang teaches the unstructured data comprises a well-formed XML document stored within a column of a table stored in the database [Fig. 3].

As per claim 6, the rejection of claim 1 is incorporated and Nishizawa teaches:

fields of the electronic record are filled with XML data based on a predefined mapping to multiple data sources [paragraph 0117, 0118, Fig. 4, 9].

As per claim 13, the rejection of claim 12 is incorporated and it encompasses limitations that are similar to limitations of claim 4. Thus, it is rejected with the same rationale applied against claim 4 above.

As per claim 14, the rejection of claim 13 is incorporated and it encompasses limitations that are similar to limitations of claim 5. Thus, it is rejected with the same rationale applied against claim 5 above.

As per claim 15, the rejection of claim 14 is incorporated and it encompasses limitations that are similar to limitations of claim 6. Thus, it is rejected with the same rationale applied against claim 6 above.

As per claim 20, the rejection of claim 19 is incorporated and it encompasses limitations that are similar to limitations of claim 4. Thus, it is rejected with the same rationale applied against claim 4 above.

As per claim 21, the rejection of claim 20 is incorporated and it encompasses limitations that are similar to limitations of claim 5. Thus, it is rejected with the same rationale applied against claim 5 above.

As per claim 22, the rejection of claim 21 is incorporated and it encompasses limitations that are similar to limitations of claim 6. Thus, it is rejected with the same rationale applied against claim 6 above.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig et al (US Pub. No. 2001/0021928) in view of Nishizawa et al. (US Pub. No. 2001/0039545) in view of Spitz (US Patent No. 7,039,807) in view of Alley et al (US Pub. No. 2003/0078880) and in view of in view of Hawkins et al (US Patent No. 7,146,500) and in view of Kato et la (US Pub. 2002/0040431).

As per claim 8, the rejection of claim 7 is incorporated and Nishizawa teaches the electronic record comprises the XML document [Fig. 9].

Kato teaches data from the electronic record is display according to a predefined layout set forth in an XSL style sheet [paragraph 0077].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Chang with Ludwig, Nishizawa and Spitz and Alley, since one would have been motivated to provide secure environment and safe storage for storing the electronic record [Hawakins, col. 1 lines 8-9].

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig et al (US Pub. No. 2001/0021928) in view of Nishizawa et al. (US Pub. No. 2001/0039545) in view of Spitz (US Patent No. 7,039,807) in view of Alley et al (US Pub. No. 2003/0078880) and in view of in view of Hopkins et al (US Patent No. 7,093,133).

As per claim 9, the rejection of claim 1 is incorporated and Hopkins teaches:

The rule requires a plurality of different electronic signatures and wherein, if execution of the rule results in a determination that a plurality of electronic signatures are required, requesting the plurality of electronic signatures [col. 2 lines 30-38].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Hopkins with Ludwig, Nishizawa and Spitz and Alley, since one would have been motivated to provide a reliable and secure means of authenticating digital messages/records [Hopkins, col. 2 lines 22-23].

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig et al (US Pub. No. 2001/0021928) in view of Nishizawa et al. (US Pub. No. 2001/0039545) in view of Spitz (US Patent No. 7,039,807) in view of Alley et al (US Pub. No. 2003/0078880) in view of Chang et al (US Patent No. 6,584,459).

As per claim 25, Ludwig teaches:

automatically creating an electronic record from data stored in a plurality of different database tables associated with a database transaction in response to an occurrence of a predetermined event [Fig. 6, paragraph 0044, 0045, 0054, Fig. 7]; initiating a request to collect the required electronic signature prior to committing the database transaction to the database [Fig. 7, paragraph 0055, Fig. 11, 12, paragraph 0067-0078].

Ludwig teaches collecting the electronic signature for the electronic record as above.

Nishizawa teaches:

storing an instance of the electronic record in a common repository of electronic records that provides an audit trail that cannot be altered or disabled by users of associated with the database [Fig. 2, paragraph 0100, Fig. 7].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Nishizawa with Ludwig, since one would have been motivated to manage the electronic documents by which user can easily confirm the original entity of an electronic document [Nishizawa, paragraph 0013].

Nishizawa teaches the electronic record with an electronic signature [paragraph 0127]. Nishizawa doesn't expressively mention a rule associated with the electronic record to determine whether an electronic signature is required.

Spitz teaches executing a rule associated with the electronic record to determine whether an electronic signature is required to connote review and/or approval of the electronic record [col. 3 lines 31-38 col. 6 lines 60-67]; and if execution of the rule results in a determination that an electronic signature is required, initiating a request to collect the required electronic signature [col. 6 lines 15-19].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Spitz with Ludwig and Nishizawa, since one would have been motivated to disguise the sensitive internal information and avoid an additional burden to the recipients duties [Spitz, col. 3 lines 1-13].

Nishizawa and Spitz do not expressively mention marking the instance of the electronic record as unsigned.

Alley teaches marking the instance of the electronic record as unsigned [Fig. 3, paragraph 0090 lines 16-19].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alley with Ludwig, Nishizawa and Spitz, since one would have been motivated to provide a electronic signature and manage the digital documents [Alley, paragraph 0014].

Nishizawa teaches the electronic record comprises unstructured data [paragraph 0016, 0017]. Nishizawa doesn't expressively mention a character large object (CLOB) format.

Chang teaches unstructured well-formed XML data stored in a character large object (CLOB) format [Fig. 3].

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Chang with Ludwig, Nishizawa, Spitz and Alley, since one would have been motivated to manage and store the digital documents [Alley, paragraph 0014].

Response to Amendment

9. Applicant's submission for RCE filed on May 27, 2008 has been entered. Applicant has amended claims 1, 11, 18, 25, which necessitated new ground of rejection. See rejection above.

Double patenting rejection is maintained based on the applicant remark presented on Sep. 18, 2007.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIRAV PATEL whose telephone number is (571)272-5936. The examiner can normally be reached on 8 am - 4:30 pm (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NBP

7/24/08

/HOSUK SONG/

Primary Examiner, Art Unit 2135